

REMARKS

Claims 1-13 and 16 are pending in the application. Claims 14-15, and 17-25 were previously canceled.

Claims 1, 4, 6, 7, 9, 10, and 16 are amended herein. Claims 5, 8, 11, 12 and 13 are canceled herein; the latter two claims are canceled as drawn to a non-elected invention. No new matter has been introduced by way of the aforementioned amendments. Claims 4, 6, 7, 9 and 10 have been amended, in full or in part, to change the indefinite article to a definite article to overcome the examiner's objection thereto, and to specify nucleic acid molecules encoding guinea pig, as opposed to mammalian, histamine H4 receptors, in accordance with the subject matter claimed in this divisional application. Those amendments do not alter the scope of the claims in any way. The support for the amendment to claim 1 may be found throughout the specification, particularly on page 21, line 25 through page 22, line 20, and in claim 1 as originally filed.

Amendments Overcoming Objections to the Specification and Claims

The disclosure stands objected to because of informalities. Applicants have amended the specification to correct these apparent informalities, as follows: 1) the title is now directed to DNAs encoding a guinea pig histamine receptor of the H4 subtype; 2) the specification now reflects that application 09/790849, from which priority is claimed, has been abandoned; 3) on page 11, the correct designation of the molecular weight of the protein is indicated as 44, 495 Daltons; 4) the Examples are sequentially numbered; 5) the reference to a PCR-generated sequence depicted by Figure 6, on page 39 has been removed; and 6) the title of the Clark et al., Agents Actions 1993 reference cited on page 53 correctly states H3.

The amino acid sequence disclosure was deemed not to comply with the requirements under 37 CFR §§1.821-1.825 because the sequences identified in Figures 1 and 2 were not identified with SEQ ID NOs. Applicants have added the correct SEQ ID NO to the Brief Description of the Drawings in the Specification.

Claims 4, 6, 7, 9, and 10 stand objected to for using indefinite articles to refer to unique sequences. Applicants have amended those claims to remove the allegedly indefinite

terminology. Claim 16 was objected to for depending from claim 6. Though Applicants believe that such dependency is proper, claim 16 has been re-drafted in independent form.

Applicants respectfully request withdrawal of the foregoing objections.

The Subject Matter of Claims 1-3 and 5 is Enabled by the Specification

Claim 1-3 and 5, stands rejected under 35 U.S.C. § 112, ¶1 as allegedly failing to comply with the enablement requirement. The Office Action first alleges that claim 1 calls for a nucleic acid molecule that encodes a histamine H4 receptor, but the specification does not teach how to use a polypeptide encoded by polynucleotides that are complementary to an H4-encoding sequence, per subparagraph (b) and originally-filed subparagraph (d) of claim 1. The Office Action further alleges that the specification does not teach how to use a polynucleotide comprising at least 15 sequential bases of the polynucleotide of (a), as specified in subparagraph (c), as filed.

Applicants respectfully traverse the rejection as applied to the presently amended claims. Claim 1 has been amended to recite an isolated nucleic acid molecule encoding a guinea pig histamine H4 receptor, or an isolated nucleic acid molecule complementary thereto. Accordingly, the subject matter of claim 1, subparagraph (b) and originally-filed subparagraph (d) (now subparagraph (c) as amended) is fully enabled. To facilitate prosecution, claim 1 has also been amended to remove original subparagraph (c) of claim 1. Thus, the grounds for the rejection with respect to that subparagraph are rendered moot. Accordingly, Applicants respectfully request withdrawal of the rejection.

The Specification Provides a Complete Written Description of Claims 1-3, 5, 8 and 11

Claim 1-3 are rejected under 35 U.S.C. § 112, ¶1 as allegedly failing to provide a complete written description of the invention. The Office Action states that subparagraph (c) (as filed) of claim 1 is drawn to isolated polynucleotides encoding mammalian histamine H4 receptors that comprise at least 15 consecutive nucleotides, yet the specification allegedly does not provide guidance as to which 15 nucleotides should be used.

Applicants respectfully disagree with the rejection. However, as set forth above, claim 1 has been amended to remove the original subparagraph (c). Thus, the grounds for the rejections are rendered moot.

Claims 5, 8, and 11 stand rejected under 35 U.S.C. § 112, ¶1 as failing to meet the written description requirement by containing subject matter which allegedly was not adequately described in the specification.. Specifically, the Office Action alleges that while specific cDNA sequences encoding the claimed receptors were disclosed, no genomic sequences were disclosed, and that there are no well-established rules, techniques, or procedures to allow the skilled artisan to determine the genomic sequence given the disclosed cDNA sequences.

Applicants respectfully disagree with the rejection. However, to advance prosecution, claims 5, 8, and 11 have been canceled, without prejudice, herein. Thus, the grounds for the rejection are rendered moot.

For the foregoing reasons, reconsideration and withdrawal of the rejections under 35 U.S.C. §112, first paragraph, for lack of adequate written description, are requested.

The Subject Matter of Claims 1-3 and 5 is Novel

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Behan et al. (US Pat. No. 6,204,017) ("Behan"). The Office Action alleges that the nucleotide sequence taught by Behan meets all the limitations of subparagraph (c) of claim 1, as it appeared in the originally filed claim.

Applicants respectfully disagree with the rejection. However, as noted above, claim 1 has been amended to remove the original subparagraph (c) from claim 1. Therefore, Behan cannot be said to identically disclose the subject matter of claim 1 as presently amended. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

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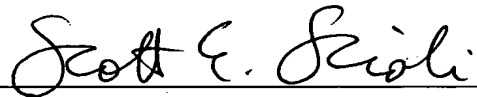
Conclusion

Applicants assert that all claims now pending in this application are in condition for allowance. The issuance of a Notice of Allowance at an early date is earnestly requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, the undersigned may be contacted at 215-568-3100.

Respectfully submitted,

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